

Appl. No. 10/738,430  
Examiner: BALAOING, ARIEL A, Art Unit 2683  
In response to the Office Action dated March 6, 2006

Date: June 6, 2006  
Attorney Docket No. 10113501

## REMARKS

Responsive to the Office Action mailed on March 6, 2006 in the above-referenced application, Applicant respectfully requests amendment of the above-identified application in the manner identified above and that the patent be granted in view of the arguments presented. No new matter has been added by this amendment.

### Present Status of Application

Claims 1-21 are pending in the application. Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 1-4, 6-11, 13-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaguchi et al (US 2002/0094841 A1, hereinafter "Sakaguchi") in view of Ito et al (EP 947 944 A2, hereinafter "Ito"). Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaguchi in view of Kao et al (US 2002/0227763 A1, hereinafter "Kao").

In this paper, claims 1 and 10 are amended to recite, *inter alia*, that the holder is a sliding holder slidable between a first position and a second position. Support for the amendment can be found at least in Figs. 5a-5c, which illustrate holder 20 sliding from a first position (Fig. 5a) to a second position (Fig. 5b) and back again (Fig. 5c).

Reconsideration of this application is respectfully requested in light of the amendments and the remarks contained below.

### Rejections Under 35 U.S.C. 112

Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner alleges that there is no support in the application as filed for the recited second position in which the holder is not overlapping the second concave portion. Applicant respectfully traverses the rejections for the reasons as follow.

Appl. No. 10/738,430  
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Applicant first notes that the limitations noted by the Examiner are present in claims 1-9, 11-17 and 19-21. Claims 10 and 18 do not recite a first and second concave portion.

Fig. 4b illustrates the holder 20 assembled to the body 10 and in a first position in which the holder overlaps a second concave portion 12. This figure corresponds to Fig. 5a. It is particularly noted that in this embodiment, it is the portion of the holder 20 comprising the inclined surface 23 that is overlapping the second concave portion 12.

As shown in Fig. 5b, as SIM card 30 is disposed in the second concave portion of the body, the SIM card is abutted by the holder so that the holder is slid to a second position. Applicant submits that Fig. 5b unambiguously illustrates that holder 20 is not overlapping the second concave portion when in this second position. It is particularly noted that in this embodiment, the portion of the holder 20 comprising the inclined surface 23 is not overlapping the second concave portion 12.

For at least these reasons, it is Applicant's belief that claims 1-21 are fully supported by the application as filed.

#### Rejections Under 35 U.S.C. 103(a)

Claims 1-4, 6-11, 13-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaguchi in view of Ito. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaguchi in view of Kao. To the extent that the grounds of the rejections may be applied to the claims now pending in this application, they are respectfully traversed.

MPEP 2142 reads in part:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

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Attorney Docket No. 10113501

claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In connection with the third criteria, MPEP 2143.03 goes on the state:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Whether taken alone or in combination, Sakaguchi and Ito fail to teach or suggest a mobile phone with a SIM card holder comprising a sliding holder disposed in a first concave portion of a body, the holder slidable between a first position overlapping a second concave portion of the body and a second position not overlapping the second concave portion, as recited in claim 1.

Sakaguchi teaches a SIM card mounting structure of a mobile phone including a SIM card receiving recess for receiving the SIM card and a pressing portion. One end of the pressing portion is integral with the receiving recess, while the other end functions as a leaf spring elastically pressing the SIM card received in the recess. See Figs. 1A-2B and paragraph 0028 of Sakaguchi. As disclosed by Sakaguchi, the pressing portion is fixed to one side of the receiving recess and permanently overlaps a portion of the receiving recess.

Ito teaches a card reader connector comprising a body 2 and a cover 4 pivotably mounted on the body via pivot pins 3 for movement between an open and closed position, thereby bringing the SIM card into contact with electrical connectors provided on the body. See the Abstract and Figs. 1 and 6-7 of Ito. Upon removal of SIM card 45, the interengagement of the locking means is released by slidingly moving cover 4 against the resilience of leaf spring 35 in the direction of PUSH arrow 47 (paragraph 34). That is, the cover 4 does not slide between an open and closed position, the cover slides to withdraw the SIM card but still overlaps with the SIM card.

Appl. No. 10/738,430  
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Attorney Docket No. 10113501

Claim 1 recites a **sliding** holder disposed in a first concave portion of a body, the holder **slidable** between a first position overlapping a second concave portion of the body and a second position not overlapping the second concave portion. In contrast, Sakaguchi teaches that the pressing portion is integrally formed with the recess, and therefore bends instead of slides. In Ito, on the other hand, the cover is pivotably mounted to the body via pivot pins, and therefore rotates between an open and closed position instead of slides. Thus, in neither reference is the alleged "holder" slidable between a first and second position as recited in claim 1.

Furthermore, the Examiner specifically relies on Ito to teach a holder movable between a first position overlapping a second concave portion of the body and a second position not overlapping the second concave portion. However, as noted above, cover 4 is not **slidable** between a first position overlapping a second concave portion of the body and a second position not overlapping the second concave portion. To the contrary, cover 4 **rotates** about a pivot between an open and closed position.

Whether taken alone or in combination, Sakaguchi and Ito fail to teach or suggest a SIM card removably disposable in the second concave portion of the body, wherein the SIM card is abutted by the holder so that the holder is slid to the second position from the first position during the disposition of the SIM card in the second concave portion, and the holder returns from the second position to the first position so as to fix the SIM card in the second concave portion when the SIM card is located in the second concave portion, as recited in claim 1.

As recited in claim 1, the SIM card is abutted by the holder so that the holder is **slid** to the second position **not overlapping the second concave portion** from the first position **overlapping the second concave portion** during the disposition of the SIM card in the second concave portion.

As noted above, neither Sakaguchi nor Ito teach or suggest a holder that is slidable between a first position and a second position as recited in claim 1. Furthermore, neither reference teaches a structure in which it is the abutment of the SIM card and holder during the disposition

Appl. No. 10/738,430  
Examiner: BALAOING, ARIEL A, Art Unit 2683  
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Date: June 6, 2006  
Attorney Docket No. 10113501

of the SIM card in the second concave portion that slides the holder to the second position not overlapping the second concave portion from the first position overlapping the second concave portion.

To the contrary, in the Sakaguchi structure, the SIM card simply moves the pressing portion between two positions that both overlap the second concave portion. In the Ito structure, on the other hand, the cover is moved to an open or closed position without interaction with the SIM card. ***In particular, Applicant notes that only after the cover is open is the SIM card inserted therein or removed there from.*** While it is not clear what the Examiner considers to be the first or second concave portions in this reference, it is clear that the abutment of the SIM card and cover during the disposition of the SIM card in the cover does not slide the cover from a first position overlapping the second concave portion to a second position not overlapping the second concave portion.

Whether taken alone or in combination, Sakaguchi and Ito fail to teach or suggest a mobile phone with a SIM card holder comprising a sliding holder disposed on the body, the holder slidable between a first position and a second position, as recited in claim 10.

***Applicant first notes that the rejections of claim 10 appear to be directed to the limitations of claim 1.*** In particular, Applicant notes that claim 10 does not recite a first or second concave portion, as alleged on page 6 of the office action.

As noted above, Sakaguchi teaches that the pressing portion is integrally formed with the recess, and therefore bends instead of slides. In Ito, on the other hand, the cover is pivotably mounted to the body via pivot pins, and therefore rotates between an open and closed position instead of slides. Thus, in neither reference is the alleged "holder" slidable between a first and second position with the features recited in claim 10.

Whether taken alone or in combination, Sakaguchi and Ito fail to teach or suggest a SIM card removably disposable on the body, wherein the SIM card is abutted by the holder so that the holder is slid to the second position from the first position so as not to overlap the SIM card during disposition of the SIM card on the body, and the holder returns from the second

Appl. No. 10/738,430  
Examiner: BALAOING, ARIEL A, Art Unit 2683  
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Date: June 6, 2006  
Attorney Docket No. 10113501

position to the first position to overlap the SIM card so as to fix the SIM card on the body when the SIM card is located on the body, as recited in claim 10.

Claim 10 recites that the SIM card is abutted by the holder so that the holder is *slid* from the first position to the second position **so as not to overlap the SIM card** during disposition of the SIM card on the body, and the holder returns from the second position to the first position **to overlap the SIM card** so as to fix the SIM card on the body when the SIM card is located on the body.

As noted above, neither Sakaguchi nor Ito teach or suggest a holder that is slid between a first position and a second position with the features recited in the claim. Furthermore, neither reference teaches a structure in which it is the abutment SIM card and holder during the disposition of the SIM card in the body that slides the holder to the second position so as not to overlap the SIM card.

To the contrary, in the Sakaguchi structure, the SIM card simply moves the pressing portion between two positions that both overlap the SIM card. In the Ito structure, on the other hand, the cover is moved to an open position without interaction with the SIM card, and only after the cover is open is the SIM card inserted therein. Furthermore, as noted above, while the cover in Ito slides to withdraw the SIM card, it still overlaps with the SIM card. In neither Ito nor Sakaguchi does the cover return from a position not overlapping the SIM card to a position to overlap the SIM card when the SIM card is located on the body, as recited in claim 10.

It is therefore Applicant's belief that even when taken in combination, the prior art references relied upon by the Examiner do not teach or suggest all the limitations of claims 1 and 10. For at least this reason, a *prima facie* case of obviousness cannot be established in connection with these claims. Furthermore, as it is Applicant's belief that a *prima facie* case of obviousness is not established for claims 1 and 10, the Examiner's arguments in regard to the dependent claims are considered moot and are not addressed here. Allowance of claims 1-21 is respectfully requested.

Appl. No. 10/738,430  
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The proposed combination of the Sakaguchi and Ito changes the principle of operation of the reference.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Also see MPEP 2143.01. In *In re Ratti*, the court held the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate."

In Sakaguchi, a SIM card is received in a receiving recess (the alleged second concave portion of claim 1) and held in place by a pressing portion (the alleged holder of claim 1). In Ito, on the other hand, a SIM card is received in a cover (the alleged holder of claim 1) and then the cover is rotated to a closed position bring the SIM card into the body 2.

Applicant submits that the modification of Sakaguchi to include the pivoted cover for receiving the SIM card of Ito would require a complete redesign of the former changing the principle of operation of the reference. In particular, Applicant draws the Examiner's attention to paragraph 0015 of Sakaguchi, which reads:

As mentioned, according to the present invention, it is possible to provide an inexpensive SIM card mounting structure of a mobile phone ***by forming a spring of a plastic material in a portion of a casing of the mobile phone without using a specially dedicated part ...***

[Emphasis added]

Applicant submits that the Examiner's proposed modification would involve just the opposite of this teaching—namely, it would replace the integrated spring of a plastic material with a specially dedicated part, i.e., a cover and pivot assembly.

Appl. No. 10/738,430  
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Attorney Docket No. 10113501

Furthermore, removal of the integrated spring of plastic material would also remove the feature of automatically returning from the second position to the first position after the SIM card is inserted. In particular, Applicant notes that the cover/pivots structure that would replace the integrated spring of plastic material does not possess such a feature.

Finally, with respect to claims 1-9, 11-17 and 19-21, if the pivoting cover for receiving the SIM card of Ito were implemented in Sakaguchi, the alleged first concave portion of Sakaguchi would play no part in operation of the cover. On the other hand, as noted above, it is not clear what the Examiner considers to be the first or second concave portions of Ito. Namely, if the Examiner considers some portion of the body the second concave portion and some portion of the cover to be the first concave portion, it is unclear how the cover can be "disposed in the first concave portion", i.e., disposed in itself.

For at least these reasons, Applicant submits that the rejection of claims 1-21 should be withdrawn.

#### Conclusion

The Applicant believes that the application is now in condition for allowance and respectfully requests so.

Respectfully submitted,



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